

REMARKS

Claims 24-30, 36-40, 42-43, 45-48 are pending in the present application. By this Amendment, claims 36-39 and 47 are amended solely for the purposes of clarity and precision, and in accordance with the July 15, 2002 telephone conference between Applicant's representatives and the Examiner. Applicant submits that the amendments are not believed to be narrowing, nor do they raise new issues requiring further search and/or consideration. Applicant respectfully requests withdrawal of the rejection, and allowance of the claims.

I. Claims 36-40, 42 and 47 are in proper condition

Claims 36-40, 42 and 47 stand rejected under 35 USC 112, 1st paragraph, due to alleged lack of enablement. Applicant respectfully submits that the claims are properly enabled for at least the reasons discussed in greater detail below.

As shown in the foregoing amendments, Applicant has amended the claims in accordance with the comments provided by the Examiner to Applicant's representatives during the above-referenced telephone conference. More specifically, Applicant has amended independent claim 36 as discussed during the July 15, 2002 telephone conference, and has correspondingly amended the dependent claims to maintain proper antecedent basis without narrowing the claims or adding matter requiring further search or consideration.

Applicant respectfully submits that the claims are properly enabled, such that one of ordinary skill in the art would be able to make or use the invention without undue experimentation. Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, 1st paragraph.

II. Claims 24-28, 30, 36-39, 42, 43 and 46-48 are novel

Claims 24-28, 30, 36-39, 42, 43 and 46-48 stand rejected due to alleged anticipation under 35 USC 102(e) over Nelson (U.S. Patent No. 5,710,605). Applicant respectfully submits that Nelson fails to disclose all of the claimed combinations of features recited in those claims, as required for an anticipation rejection under §102. Therefore, Applicant respectfully requests withdrawal of the rejection, and allowance of the claims.

Nelson discloses a remote controller that allows a user to select between programming schedules. As illustrated in Figure 1 of Nelson, four separate direction keys 52, 58, 60, 62 are provided, with an enter key 50 surrounded by the direction keys 52, 58, 60, 62. Applicant notes that there is a space between the enter key 50 and the direction keys 52, 58, 60, 62, and submits that Nelson does not disclose that all of these keys can be operated without the user repositioning the part of his body that is in contact with the keys (e.g., finger).

Applicant respectfully submits that Nelson fails to disclose all of the claimed combinations of features recited in claims 24-28, 30, 36-39, 42, 43 and 46-48. For example, but not by way of limitation, Applicant respectfully submits that Nelson fails to disclose (or even suggest) operating both the movement and execution keys without repositioning the user's body part, as recited in independent claims 24 and 43. Also, Applicant respectfully submits that Nelson fails to disclose (or even suggest) operating both the plurality of contacts and the central contact without repositioning the user's body part, as recited in independent claim 36.

As noted above, the keys illustrated in Nelson are clearly separate and distinct from one another, and are spaced apart such that the user must reposition the finger (i.e., move the finger

between keys) to perform the operations of Nelson. Further, Applicant respectfully submits that Nelson would not operate properly if the finger of the user was not substantially repositioned, because more than one directional button in an opposite direction would remain depressed, such that the cursor would not move in the proper direction.

Additionally, attempting to use Nelson without moving the user's finger would result in the enter key 50 being depressed when the user intends to move the cursor without actually depressing the enter key 50. Therefore, Applicant respectfully requests withdrawal of the rejection of independent claims 24, 36 and 43

Claims 25-30, 45 and 46 depend from independent claim 24, claims 37-40, 42 and 47 depend from independent claim 36, and claim 48 depends from independent claim 43. Applicant respectfully submits that the dependent claims are allowable for at least the same reasons as the independent claims from which they depend. Therefore, Applicant respectfully requests withdrawal of the anticipation rejections under 35 U.S.C. § 102(e), and allowance of the claims.

III. Claims 24-30, 36-40, 42, 43 and 45-48 would not have been obvious

Claims 24-30, 36-40, 42, 43 and 45-48 stand rejected due to alleged obviousness under 35 U.S.C. § 103(a) over the combination of JP-5-244241 (hereafter "JP '241'")) and either Nelson or Okhura et al. (U.S. Patent No. 5,737,029, hereafter "Okhura"). Also, claim 40 stands rejected due to alleged obviousness over the combination of Nelson and either Okhura or JP-6-232992 (hereafter "JP '992'"), and claims 29 and 45 stand rejected under section 103 over Nelson in view of August et al. (U.S. Patent No. 5,671,267, hereafter "August").

Applicant respectfully submits that the Examiner's proposed combinations of references fail to disclose or suggest all of the claimed combinations of features, as required for a prima facie obviousness rejection. Thus, Applicant respectfully requests withdrawal of the rejection, and allowance of the claims.

JP '241 discloses a device having a four-direction movement key 7 positioned to the left of an execution key 8. However, JP '241 clearly requires that the user reposition the portion of their body that is in contact that the keys in order to perform their respective functions.

Applicant respectfully submits that the Examiner's proposed combinations of references fail to disclose or suggest the claimed combinations of features. For example, but not by way of limitation, Applicant respectfully submits that the Examiner's proposed combination of JP '241 and either Okhura or Nelson fails to disclose or suggest that the movement key pad and the execution key are operated without requiring a user to substantially reposition a user body part that contacts the first key section, as recited in independent claims 24 and 43, or operating both the plurality of contacts and the central contact without repositioning the user's body part, as recited in independent claim 36.

As acknowledged by the Examiner, JP '241 does not disclose that the movement key pad and the execution key are operated without requiring a user to substantially reposition a user body part that contacts the first key section, as recited in independent claims 24 and 43. Applicant respectfully submits that this statement also applied to the plurality of contacts and the central contact that are operated without requiring repositioning of the user's body part, recited in independent claim 36.

The Examiner proposes to combine either Nelson or Okhura with JP '241 to cure this deficiency. However, Applicant respectfully submits that as discussed above in section II, Nelson requires the user to substantially reposition their finger to properly operate Nelson, due to the separation of the directional keypads 52, 58, 60, 62 from the execution keypad 50. Therefore, the combination of JP '241 with Nelson does not cure the acknowledged deficiencies of Nelson.

Further, Applicant respectfully submits that Okhura cannot be properly combined with JP '241. As shown above, JP '241 clearly shows a directional key 7 positioned next to an enter key 8. In contrast, Okhura discloses a single key 52. Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combined the references to produce the claimed combinations of features. Applicant submits that the only apparent motivation is the presently claimed invention, which constitutes impermissible hindsight reconstruction. Thus, Applicant respectfully submits that the deficiency is not cured by the Examiner's proposed combinations of references.

Claims 25-30, 45 and 46 depend from independent claim 24, claims 37-40, 42 and 47 depend from independent claim 36, and claim 48 depends from independent claim 43. Applicant respectfully submits that the dependent claims would not have been obvious for at least the same reasons as the independent claims from which they depend.

Therefore, Applicant respectfully requests withdrawal of the anticipation rejections, and allowance of the claims.

IV. Conclusion

Amendment Under 37 C.F.R. § .116
U.S. Appln. No. 09/192,303

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Mainak H. Mehta
Registration No. 46,924

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: September 4, 2002

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

36. (Twice amended) A portable communication apparatus having a display section and a key operation section on one side of a housing, the key operation section comprising:

a first key section including a [movement key pad which is]plurality of contacts used to move a highlighted portion indicating one of a plurality of information items displayed in the display section, and [an execution key]a central contact used to executed a highlighted information item; and

a second key section including a ten key pad, wherein the first key section and the second key section are adjacent to each other on the one side,

wherein the [movement key pad]plurality of contacts and the [execution key]central contact are disposed within an area of the first key operation section immediately below the display section,

wherein the display section displays a plurality of information items in a plurality of rows and columns, and

wherein the [movement key pad]plurality of contacts allows four-way movement among a group of information items on a column in which the highlighted portion exists to be scrolled, and said [movement key pad]plurality of contacts and said [execution key]central contact are operated without requiring a user to substantially reposition a user body part that contacts said first key section.

37. (Amended) The portable communication apparatus according to claim 36, wherein the area of the first key operation section in which [movement key pad]plurality of contacts and the [execution key]central contact are disposed is disposed with a space from other areas of the first key operation section.

38. (Amended) The portable communication apparatus according to claim 36, wherein the [movement key pad]plurality of contacts [comprises a plurality of movement operation keys used to instruct]instructs different movement directions of the highlighted portion; and

the [execution key]central contact comprises an enter key disposed at a position sandwiched by the plurality of movement operation keys.

39. (Amended) The portable communication apparatus according to claim 36, wherein the [movement key pad]plurality of contacts comprises a plurality of switch contacts used to instruct different movement directions of the highlighted portion; and

the [execution key]central contact comprises a depression switch contact disposed at a position sandwiched by the plurality of switch contacts.

47. (Amended) The method of claim 36, wherein said [movement key pad]plurality of contacts and said execution key are operated without removing said body part from said first key section.